



Patent
Attorney's Docket No. 1016800-000515

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of) **MAIL STOP: AMENDMENT**
Olivier De Lacharrière et al.)
Application No.: 10/602,823) Group Art Unit: 1649
Filed: June 25, 2003) Examiner: Aditi Dutt
For: NON-THERAPEUTIC METHODS) Confirmation No.: 1993
OF EVALUATING SKIN)
NEUROSENSITIVITY, KIT AND)
USE OF A KIT FOR)
IMPLEMENTING THE METHOD)

ELECTION WITH TRAVERSE UNDER 37 CFR 1.143

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Responsive to the Office Action dated May 16, 2006, (with the period for response extended one month by payment of the enclosed fee) and in compliance with 37 C.F.R. § 1.143, Applicants provisionally elect with traverse the Group I invention (Claims 1-63) directed to method for evaluating the level of skin neurosensitivity and identifying persons having sensitive skin.

As required by 35 U.S.C. § 121, Applicants elect capsaicin as the species for prosecution on the merits.

The Group I election reads on Claims 1-63. The elected species reads on at least Claims 16, 17, 53 and 54.

Although the Examiner has pointed out that if the process claims (the elected claims) are found allowable the withdrawn claims (Claims 64-67 directed to a kit) could

be rejoined according to M.P.E.P. § 821.04, Applicants respectfully request and urge the Examiner to examine the present application in its entirety.

The restriction requirement is respectfully traversed. 35 U.S.C. § 121 is permissive, not mandatory, and accordingly M.P.E.P. § 808 requires not only clarification of the reasons why inventions as claimed are independent and distinct but also the reasons for insisting on restriction therebetween. Furthermore, the Commissioner's notices appearing in 934 OG 2 and 922 OG 1016 urge examination of an entire application on the merits if this can be made without serious burden on the Examiner, even in cases which includes claims to distinct or independent inventions. Applicants believe that the entire invention as claimed can be examined without serious burden to the Examiner since the kit is a fundamental part of all other aspects of the claimed subject matter and accordingly **provides unity of invention**. M.P.E.P. § 800 specifically states that if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Also it is noted that the restriction requirement fails to state that the many inventions are independent and distinct, rather, only distinct.

If, the Patent and Trademark Office intends to divide the present application into a plurality of Examiner-determined inventions and restrict prosecution of the present application to one aspect of the subject matter which Applicants regard as their invention, equity requires that the factual basis for so holding be clearly delineated so that the record will reflect if such a requirement is proper under 35 U.S.C. § 121.

The importance of the written record clearly setting forth the reasons upon which a restriction requirement is based, particularly with respect to claims to a compound or composition held patentably distinct by the Patent and Trademark Office over method of use claims, is increasingly apparent from a brief filed by the Justice Department in *U.S. v. Union Carbide Corp.*, an antitrust action in the U.S. District Court for Northern California seeking to invalidate U.S. Patent No. 3,009,855 on the insecticide "Sevin". In that case, the Patent and Trademark Office has insisted that the original application, claiming both a product and method of use, be restricted and merely alleged that the two constituted "distinct" inventions. Applicants retained product claims in the original application and canceled method claims which were presented in a divisional application. Some 20+ years later, the Justice Department argued in its brief that the restriction requirement was clearly not authorized under 35 U.S.C. § 121, since the statute imposes the dual criteria that restrictable inventions must be both independent and distinct, stating in its brief:

...it is clear that the product carbaryl and its only disclosed use, e.g., killing insects, are not "independent and distinct" inventions. Since the first application expressly discloses how to use carbaryl as an insecticide in order to meet the statutory requirements for patentability, it cannot properly be said there is "no disclosed relationship" between the product carbaryl and its disclosed use as an insecticide. Nor can it be correctly said that the product carbaryl is "unconnected in design, operation or effect" with its use to kill insects. Thus it is clear that the restriction requirement which was imposed on the first application lacked authority under 35 U.S.C. 121 because that application did not claim "two or more independent and distinct inventions".

In view of the above, reconsideration and withdrawal or at least clarification of the restriction requirement is requested and an early action on the merits are courteously requested.

Respectfully submitted,

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